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In re Application of
Britton
Application No. 09/412,993
Filed: October 5, 1999
Attorney Docket No. R0027
For: PROVIDING AUDIENCE FLOW IN A
PERSONAL TELEVISION DEVICE

: ON PETITION

AUG 13 2003

OFFICE OF PETITIONS

This decision addresses two petitions: (1) the petition under 37 CFR 1.47(b), filed January 23, 2002 (certificate of mailing date December 19, 2001) and supplemented on February 12, 2002 and (2) the reconsideration petition under 37 CFR 1.137(b), filed January 23, 2002 (certificate of mailing date December 19, 2001), to revive the above-identified application. The Office apologizes for the delay in addressing these petitions.

The petition under 37 CFR 1.47(b) is **dismissed**.

The petition under 37 CFR 1.137(b) is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(b) and 1.137(b)." Petitioners are advised that this is not a final agency decision.

On November 1, 1999, the Office mailed a Notice to File Missing Parts of Nonprovisional Application, which set forth an extendable two (2) month period to submit an executed oath or declaration, filing fees, and a \$130.00 surcharge under 37 CFR 1.16(e) for their late filing. No response was received. Thus, this application became abandoned on January 2, 2000. On May 14, 2001, petitioner filed a petition to revive under 37 CFR 1.137(b), the required petition fee, and filing fees. The petition under 37 CFR 1.137(b) was dismissed on June 19, 2001 for failure to provide a complete reply -- a signed declaration was missing.

The instant petitions and a 4 month extension of time and required fee were filed in response.

PETITION UNDER 37 CFR 1.47(b)

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
- (2) an acceptable oath or declaration;
- (3) the petition fee;

- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks item (1) set forth above.

As to item (1), applicant has failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

The statement of facts of Debbie Peloquin establishes that "documents" were mailed to the inventors last known address on October 8, 2001 and they were received by a "Britton" on October 10, 2001. However, the statement of facts does not establish that a complete copy of the application was mailed. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).

Libby Hope's statement of facts buttresses the argument that Mr. Britton did not receive a complete copy of the application because when Ms. Hope spoke to Mr. Britton about the necessity of obtaining his signature on documents pertaining to this application, he "appeared to not know what [she] was talking about, and explained that he would look for the documents and call [her] back."

Mr. Britton must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. After all, Mr. Britton cannot make the necessary statements found in the declaration-- i.e. "I have reviewed and understand..." -- without having examined the patent application.

When petitioner can show that Mr. Britton was mailed or received the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration within a reasonable amount of time, petitioner will have satisfied this requirement.

If there is an express oral refusal, that fact along with the time and place of the refusal must be stated in a statement of facts. If there is a written refusal, a copy of the refusal must be submitted. Finding refusal by conduct is possible. All facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

The petition under 37 CFR 1.47(b) is dismissed.

It is noted that petitioner has not specified Mr. Britton's last known address. It is assumed that Mr. Britton's last known address is that listed in the declaration. If this is the case, please state so in any reconsideration petition.

PETITION UNDER 37 CFR 1.137(b)

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed;
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The

Commissioner may require additional information where there is a question whether the delay was unintentional; and

- (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

This petition lacks item (1) above. The required reply is an acceptable declaration -- whether executed by the inventor or executed by someone representing an entity with proprietary interest. Since the petition under 37 CFR 1.47(b) is dismissed, petitioner has not submitted the required reply to revive the application.

The petition under 37 CFR 1.137(b) is dismissed.

It is noted that on June 12, 2003, Attorney Eric R. Moran of McDonnell Boehnen Hulbert & Berghoff filed a power of attorney by assignee of entire interest on behalf of Digital Networks North America, Inc.. Mr. Moran attached an asset purchase agreement between SONICblue Incorporated, ReplayTV, Inc., and Digital Networks North America, Inc. as evidence of Digital Networks North America, Inc.'s status as assignee of the entire interest of the above-identified application. The Office requires this document to be recorded in Assignments Division before the assignee will be permitted to take action. See MPEP 324. Of course, prior to Digital Networks North America, Inc.'s intervening, Rule 47(b) status for ReplayTV, Inc. must be established.

Further correspondence with respect to this matter should be addressed as follows:

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